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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No: 09/737,844

Filed: December 15, 2000

Attorney Docket No: DP-302060

Examiner: Tran, Hien Thi

APPLICANT: Paul E. Jankowski

Group Art Unit: 1764

TITLE: Variable Flow Regulator For  
Use With Catalytic Converter

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS: Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on JUNE 9, 2004.

  
Lowell M. Train

MS: Amendment  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE  
TO OFFICE ACTION MAILED JUNE 30, 2004

Dear Sir:

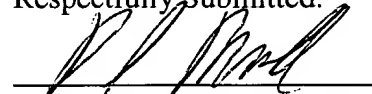
This is Applicants' response to the Office Action mailed June 30, 2004 for the above-identified application, which requires restriction between claims 1-11 (group I), 12-25 (group II), and 26-41 (group III).

Applicants acquiesce to the restriction requirement between groups I and III, but respectfully traverse the restriction requirement between groups I and II. Applicants further provisionally elect to prosecute claims 1-11 directed to a catalytic converter and method for manufacturing a catalytic converter.

The Office Action improperly characterizes the claims of group I as process of making claims, and then asserts that restriction is proper pursuant to MPEP §806.05(i) because the product is allegedly "not allowable". The Examiner is apparently applying a standard of "not allowable" to mean that the product claims have not yet been *determined* to be allowable (i.e., not yet examined on the merits). However, the cited MPEP section clearly states that this standard is not the appropriate standard for such a three-way restriction requirement. MPEP § 806.05(i) states that by "not allowable", it means "not novel and nonobvious". Such a determination that the claims are not novel and nonobvious clearly requires examination on the merits. MPEP § 806.05(i) further states that "[d]etermination of patentability of the product need not be made prior to making a requirement for restriction *unless* the requirement is based on a determination that the product claims are not allowable." (emphasis added) The Office Action clearly relies on such a purported determination in the third sentence of paragraph 2. However, since no examination has taken place in the present application upon which such a determination can be based, the restriction requirement is clearly inappropriate at this stage. Accordingly, Applicants respectfully submit that the restriction requirement is improper and should be withdrawn, at least until examination on the merits has been completed.

Please charge any necessary fees, including any extension of time, or any other fee deficiencies to Delphi Technologies, Inc., Deposit Account No. 50-0831.

Respectfully Submitted:

A handwritten signature in black ink, appearing to read 'Paul L. Marshall', is written over a horizontal line.

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PLM:lt